

**Remarks**

**A. Status of the Claims**

No claims are amended, cancelled, or added. Therefore, claims 39-81 are pending.

**B. Obviousness Rejections**

All of the claims are rejected under 35 U.S.C. § 103(a) for allegedly being obvious over U.S. Patent 5,512,371 ("Gupta") in view of U.S. Patent 6,562,466 ("Jiang") (as to claims 39-58, 63-66, 68-70, 76, and 77) and in further view of a variety of tertiary references (as to the remaining dependent claims). The focus of this response is on the combination of Gupta and Jiang given that all of the obviousness rejections rely on this combination.

The Examiner argues that it would have been obvious at the time Applicant's invention was filed to use Jiang's unpolished lens with the single coating process disclosed in Gupta. That is, the Examiner is modifying Gupta only to the extent of replacing its polished lens with Jiang's unpolished lens. The stated apparent reason/motivation for modifying Gupta's disclosure in such a manner would be to avoid having to perform the polishing step:

It would have been obvious to a person having ordinary skill in the art to provide a fined but unpolished lens to a coating process as taught by Jiang in the method of Gupta for the purpose of eliminating the need to first polish the lens surface.

Action at page 3.

Applicant respectfully disagrees with the Examiner's reasoning. While the process disclosed in Jiang allows for the elimination of a polishing step of the lens, it does so only in the context of depositing at least two layers onto the surface of the unpolished lens. That is, the solution offered by Jiang to avoid the polishing step is the use of an accumulation of coatings (and not a monolayer coating), which results in the appearance of a polished lens that has not actually been polished (see data in Examples of Jiang).

Respectfully, the Examiner's obviousness argument hinges on excluding a key aspect of Jiang's disclosure. In particular, in order to reach the Examiner's obviousness conclusion, a person having ordinary skill in the art would actually have to ignore Jiang's solution of using multiple layers to avoid the polishing step. Under the current fact situation, a person of ordinary skill is faced with two different teachings:

- (1) According to Gupta, one must deposit a single coating onto a polished surface.
- (2) According to Jiang, one must deposit multiple coatings onto a fined but unpolished surface to achieve the appearance of a polished surface.

If Gupta is to be modified in view of Jiang's disclosure, then Applicant requests that the entire teachings of Jiang be considered, especially those teachings that are central to the rationale being used to combine these references—*i.e.*, the solution of avoiding the polishing step. The MPEP and case law require at least this much. MPEP § 2141.02 (VI) ("A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention") (underline in original).

If Jiang is considered in its entirety, then Applicant respectfully submits that the end result would be the use of Jiang's unpolished lens and multiple layers with Gupta's molds. This is the natural and obvious result for at least the following reasons. The solution offered by Gupta is a single coating layer composition for a polished lens. By comparison, Jiang's solution for using an unpolished lens is to use multiple coating layers. Therefore, if a person wishing to avoid the polishing step in Gupta were to consider Jiang, then such a person would naturally take into account Jiang's solution to avoid the polishing step. Given that Jiang's solution is the use of multiple layers, the natural and reasonable inference to be drawn would be to use the multiple

layers and unpolished lens with Gupta's process. Any other conclusion necessarily ignores the fundamental teachings of Jiang's solution.

Further, the rationale used by the Examiner at page 10 of the Action also ignores Jiang's teachings and further assumes the existence of a reasonable expectation of success without actually providing any supporting evidence. In particular, the Examiner states:

...Employing the molding device of Jiang in the method of Gupta to apply a single layer coating would not substantially alter the function of the device and a person having ordinary skill in the art at the time of the invention would have expected similar benefits in terms of an optical-quality coated surface and non-deformation of the lens blank.

Action at pages 10-11. As discussed in detail above, if one were to employ Jiang's unpolished lens with Gupta's method, then one would also investigate the solution that allows one to use an unpolished lens. Given that Jiang's solution is to use multiple layers, then reasonable conclusion to draw is to further modify Gupta to use multiple layers. There is simply nothing of record in the cited art to suggest otherwise.

Also, the Examiner's above statement assumes that using only Jiang's unpolished lens with Gupta's single coating process would result in a lens that is free of visible fining lines. This is an unreasonable position given the evidence of record. Jiang's disclosure and corresponding data revolve around multi-layer coatings. The reasonable conclusion to be made is that using multi-layer coatings on an unpolished lens works (Jiang) and that if a single layer is desired, then a polished lens is needed (Gupta). Indeed, the only evidence of record suggesting that a single layer can be used on an unpolished lens is Applicant's own data. However, Applicant's data cannot be used to support the current obviousness rejection in view of the MPEP and case law's admonition of hindsight reasoning. Therefore, there is no reasonable expectation that the Examiner's proposed modification of Gupta would work.

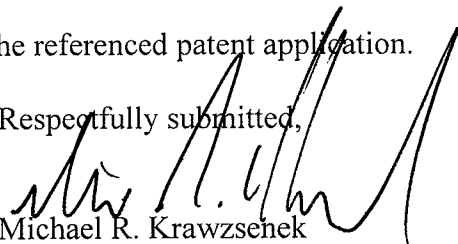
Applicant also submits that Jiang actually teaches away from the claimed invention. On the one hand, Applicant's process concerns the use of a single monolayer coating to produce a coated optical article free of visible fining lines but that has not been polished. On the other, Jiang relies on a multilayer process to produce the same effect. Therefore, a person having ordinary skill in the art upon considering Jiang would be lead down a path that is divergent from the path taken by Applicant. This is evidence that Jiang teaches away from the claimed invention. *See* MPEP § 1504.03 (III) ("A prima facie case of obviousness can be rebutted if the applicant...can show that the art in any material respect 'taught away' from the claimed invention...A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant.").

Applicant requests that all of the obviousness rejections be withdrawn for at least the above-stated reasons.

**C. Conclusion**

Applicant believes that this case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at 512-536-3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



Michael R. Krawzsenek

Reg. No. 51,898

Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
512.536.3020 (voice)  
512.536.4598 (fax)  
Date: January 31, 2011